

<b>Office Action Summary</b>	<b>Application No.</b> 09/773,054	<b>Applicant(s)</b> ECKARD ET AL.	
	<b>Examiner</b> MICHAEL P. NGHIEM	<b>Art Unit</b> 2863	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 January 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 5-8, 14-16, 19, 20, 22, 27, 30-33, 45 and 46 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 31 is/are allowed.
- 6) ☒ Claim(s) 5-8, 14-16, 19, 20, 22, 27, 30, 32, 33, 45 and 46 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. <u>20080311</u> .                           |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application  |
| Paper No(s)/Mail Date _____.   | 6) <input type="checkbox"/> Other: _____.                          |

## **DETAILED ACTION**

The Pre-Brief Appeal Conference decision has been entered on January 8, 2008.

### ***Withdrawal of Allowability***

The indicated allowability of claims 15, 16, 32, and 33 is withdrawn in view of the new ground of rejections.

### ***Specification***

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: claims 15 and 32, the "capping structure having a range of movement along an axis generally traversed to a nozzle array of the printhead" is not described in the specification.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claims 5-8, 14-16, 19, 20, 22, 27, 30, 32, 33, 45, and 46 are rejected under 35

U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In the claims, "with respect to" (claim 5, line 10; claim 7, line 10; claim 14, line 10; claim 15, line 10; claim 19, line 6; claim 20, line 6; claim 22, line 6; claim 27, line 6; claim 30, lines 7-8) is unclear. Examiner suggests replacing "with respect to" with -- in place of --.

Claim 30 lacks a transitional phrase. Thus, the metes and bounds of the claim cannot be readily ascertained. MPEP 2111.03.

Claim 30, the special service module is not comprised of a combination of elements.

Claim 32, it is not clear how by servicing the printer, the first service module can be in an "un-used" condition. Examiner suggests changing "un-used" (line 5) to -- un-worn --.

Claim 32, "the second module" (line 7) lacks antecedent basis.

Claim 45, it is not clear how by performing service on the printhead, the first service module can be in an "unused" condition. Examiner suggests changing "unused" (line 9) to -- un-worn --.

The remaining claims are also rejected under 35 U.S.C. 112, second paragraph, for being dependent upon a rejected base claim.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 15, 16, 32, and 33 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claims 15 and 32, the specification does not enabled one skilled in the art to make or use a "capping structure having a range of movement along an axis generally traversed to a nozzle array of the printhead".

Fig. 10 shows a cap structure (230E1) movable in a direction (230E7) that is perpendicular with the nozzle arrays (70A) via force of spring (230E3). Cap structure (230E1) is guided by rails or pins (230E4) for movement upwardly and downwardly in a range of movement along the directions of arrow (230E7) (specification, page 14, lines 31-34). Fig. 10 shows that the cap structure (230E1) is prevented from moving in a direction transverse to the nozzle array (70A) (i.e. side-to-side horizontal direction) by tabs next to each side of the cap structure.

***Allowable Subject Matter***

Claims 5-7, 14, 19, 20, 22, 27, 30, 45, and 46 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

Claim 31 is allowed.

### ***Reasons For Allowance***

The **combination** as claimed wherein a method for servicing an inkjet printer comprising the second service module removably installable on the printer and with respect to (i.e. in place of) the first service module (claims 5, 7, 14, 19, 20, 22, 27, 30, 31, 45) is not disclosed, suggested, or made obvious by the prior art of record.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Quintana (US 6,312,091) discloses a plastic spring-biased cap (100) (Fig. 4). Maza (US 6,471,329) discloses spring-biased cap (34) (Fig. 8).

### ***Response to Arguments***

Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Nghiem whose telephone number is (571) 272-2277. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Barlow can be reached on (571) 272-2269. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Michael P. Nghiem/

Primary Examiner, GAU 2863

March 11, 2008